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| 45965 | 7590 | 11/26/2008 | EXAMINER | |
| TIPS GROUP | | | STORK, KYLE R | |
| c/o Intellevate LLC | | | | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--------------------------------------|---------------------------------------|--|
| Office Action Summary | Application No. 09/625,300 | Applicant(s) HICKMAN ET AL. | |
| | Examiner KYLE R. STORK | Art Unit 2178 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 September 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,5,6,10-32 and 36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 5-6, 10-32 and 36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This non-final office action is in response to the amendment filed 18 September 2008.
2. Claims 1, 5-6, 10-32 and 36 are pending. Claims 1, 21, 27, 31-32, and 36 are independent claims. Claims 33-35 and 37-41 are cancelled by the amendment.

This office action has been made non-final based upon the Examiner's failure to provide a rejection to claim 32. A rejection to claim 32 has been included in this non-final office action.

The rejections of claims 1, 5-6, 10-20, and 31 under 35 USC 112 have been withdrawn as necessitated by the amendment.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 1, 5-6, 12-13 are rejected and claims 14-15, 31, and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Daleen et al. (US 6493722, filed 13 April 1999, hereafter Daleen) and further in view of Pearson (US 6023684, filed 1 October 1997) and further in view of Blumer et al. (US 5732219, patented 24 March 1998, hereafter Blumer).

As per independent claim 1, Daleen discloses an electronic filing system (column 4, lines 7-8; Figure 1, item 104: Here, the EFS is a database), wherein:

Documents are filed for further processing by a receiving agency associated with said receiving agency server in accordance with a procedure for which said receiving agency is in some manner responsible

A receiving agency server coupled to a wide area network (Figure 1, item 106)

Client machines coupled to a WAN that communicates to the receiving agency server (Figure 1, item 112)

Daleen fails to specifically disclose a web server coupled to a WAN that serves as an interface to the receiving agency server. However, Pearson shows the use of intermediate servers (Figure 2; columns 1-21). Pearson further indicates that one may employ a path such as a path from a client (Figure 2, items 26 or 28) to the web server (50) to the application server (56), allowing control and filtering of data flow. Pearson further discloses wherein the receiving agency server (Figure 2, item 48) is separate from the web server (Figure 2, item 50) and the agency computer believes it is in communication with a client machine via an interface with the web server (Figure 2). It would have been obvious to one of ordinary skill in the art at the time

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of the applicant's invention to have combined Pearson with Daleen, since it would have allowed for filtering and control of data flow.

Daleen fails to specifically disclose wherein the portion of the electronic document is automatically produced in response to a selection originating from a client. However, Blumer discloses wherein the portion of the electronic document is automatically produced in response to a selection originating from a client (column 6, lines 4-35: Here, a user submits form data. Based upon the submitted form data, the electronic document is generated). It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined Blumer with Daleen, since it would have allowed a user to automatically generate web page data.

As per dependent claim 5, Daleen, Pearson, and Blumer disclose the limitations similar to those in claim 1, and the same rejection is incorporated herein. Daleen discloses a network is the Internet, which is a TCP/IP protocol network (column 1, lines 20-57).

As per dependent claim 6, Daleen, Pearson, and Blumer disclose the limitations similar to those in claim 1, and the same rejection is incorporated herein. Daleen discloses wherein the network is the Internet (column 1, lines 20-57).

As per dependent claim 12, Daleen, Pearson, and Blumer disclose the limitations similar to those in claim 1, and the same rejection is incorporated herein. Daleen integrates a billing system including an electronic filing system wherein a server transacts a financial transaction with the receiving agency on behalf of a client machine (Abstract).

As per dependent claim 13, Daleen, Pearson, and Blumer disclose the limitations similar to those in claim 1, and the same rejection is incorporated herein. Daleen further discloses

providing a message to the user which constitutes an automated electronic filing system wherein the web server provides a portion of the electronic document in response to a selection from the client machine (Figure 5A, item 508).

As per dependent claims 14 and 15, Daleen, Pearson, and Blumer disclose the limitations similar to those in claim 1, and the same rejection is incorporated herein. Daleen further discloses wherein network machines are connected via a WAN (Figure 1).

As per independent claim 31, the applicant discloses the limitations substantially similar to those in claim 31, and the same rejection is incorporated herein. Daleen fails to specifically disclose wherein the filing is a trademark application, but the examiner takes official notice that filing of trademark application and payment for filing of such an application was notoriously well known in the art at the time of the applicant's invention. Therefore, it would have been obvious to have applied Daleen, Pearson, and Blumer to trademark applications, thereby allowing for efficient filing of trademark applications.

As per independent claim 36, the applicant discloses the limitations similar to those in claim 31. Claim 36 is similarly rejected.

6. Claims 10-11 and 18-19 are rejected and claims 16-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Daleen, Pearson, and Blumer and further in view of Blackwell, Jr. et al. (US 5857191, filed 8 July 1996, hereafter Blackwell).

As per dependent claim 10, Daleen, Pearson, and Blumer disclose the limitations similar to those in claim 1, and the same rejection is incorporated herein. Daleen fails to specifically disclose encrypting communications over a network. However, Blackwell discloses encrypting

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communications over a network (columns 1, lines 38-40). It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined Blackwell with Daleen, since it would have provided secure communications over a network.

As per dependent claim 11, Daleen, Pearson, and Blumer disclose the limitations similar to those in claim 1, and the same rejection is incorporated herein. Daleen fails to specifically disclose wherein communications between the client machine and the web server are subject to authentication. However, Blackwell discloses authentication (column 1, lines 38-40). It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined Blackwell with Daleen, since it would have provided secure communications over a network.

As per dependent claim 16, Daleen, Pearson, and Blumer disclose the limitations similar to those in claim 1, and the same rejection is incorporated herein. Daleen fails to specifically disclose encrypting communications over a network. However, Blackwell discloses encrypting communications over a network (columns 1, lines 38-40). It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined Blackwell with Daleen, since it would have provided secure communications over a network.

As per dependent claim 17, Daleen, Pearson, and Blumer disclose the limitations similar to those in claim 1, and the same rejection is incorporated herein. Daleen fails to specifically disclose wherein communications between the client machine and the web server are subject to authentication. However, Blackwell discloses authentication (column 1, lines 38-40). It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to

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have combined Blackwell with Daleen, since it would have provided secure communications over a network.

As per dependent claim 18, Daleen, Pearson, and Blumer disclose the limitations similar to those in claim 1, and the same rejection is incorporated herein. Daleen fails to specifically disclose encrypting communications over a network. However, Blackwell discloses encrypting communications over a network (columns 1, lines 38-40). It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined Blackwell with Daleen, since it would have provided secure communications over a network.

As per dependent claim 19, Daleen, Pearson, and Blumer disclose the limitations similar to those in claim 1, and the same rejection is incorporated herein. Daleen fails to specifically disclose wherein communications between the client machine and the web server are subject to authentication. However, Blackwell discloses authentication (column 1, lines 38-40). It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined Blackwell with Daleen, since it would have provided secure communications over a network.

7. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Daleen, Pearson, and Blumer and further in view of Lee, US 5347477, filed 2 March 1993).

As per dependent claim 20, Daleen, Pearson, and Blumer disclose the limitations similar to those in claim 1, and the same rejection is incorporated herein. Daleen fails to specifically disclose partially automated form filling. However, Lee discloses partially automated form filling (Abstract). It would have been obvious to one of ordinary skill in the art at the time of the

applicant's invention to have combined Lee with Daleen, since it would have allowed a user to quickly and easily fill form data.

8. Claims 21 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Paltenghe et al. (US 2001/0011250, filed 12 November 1998, hereafter Paltenghe) and further in view of Daleen and further in view of Hitchcock et al. (US 6345278, provisional filed 4 June 1998, hereafter Hitchcock).

As per independent claim 21, Paltenghe discloses storing data useful for populating an HTML based form, providing the form to a client machine coupled to a network, partially automated form filling with suitable data selected from data input from a client machine, verifying information of the form based upon stored heuristics and submitting the form to a receiving agency via a network (paragraph 0049; Figure 2).

Paltenghe fails to specifically disclose a web server coupled to the client. However, Daleen discloses a receiving agency server coupled to a wide area network (Figure 1, item 106). It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined Daleen with Paltenghe, since it would have allowed a user submit form data to a receiving agency server (Daleen: Figure 1).

Paltenghe fails to specifically disclose validation of the completeness of a form. However, Hitchcock discloses validation of the completeness of a form (column 15, lines 12-27). It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined Hitchcock with Paltenghe, since it would have allowed a user to validate the completeness of a form.

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As per independent claim 27, the applicant discloses the limitations similar to those in claim 21. Claim 27 is similarly rejected.

9. Claims 22 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Paltenghe, Daleen, and Hitchcock and further in view of Brown.

As per dependent claim 22, Paltenghe, Daleen, and Hitchcock disclose the limitations similar to those in claim 21, and the same rejection is incorporated herein. Paltenghe fails to specifically disclose verifying information. Brown further discloses that the user name is obtained at the same time as the password, constituting a method for verifying information (column 3, lines 62-63). It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined Brown with Paltenghe, since it would have allowed for secure transmission based upon user identity.

As per independent claim 28, the applicant discloses the limitations similar to those in claim 22. Claim 28 is similarly rejected.

10. Claims 23, 25-26, and 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over Paltenghe, Daleen, Hitchcock, and Brown and further in view of Holloway (US 5604802, filed 18 July 1994).

As per dependent claim 23, Paltenghe, Daleen, Hitchcock and Brown disclose the limitations similar to those in claim 22, and the same rejection is incorporated herein. Brown fails to specifically disclose obtaining an electronic signature. However, Holloway discloses use of an electronic signature (column 5, lines 35-55). It would have been obvious to one of

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ordinary skill in the art at the time of the applicant's invention since it would have allowed for secure information transactions.

As per dependent claim 25, Paltenghe, Daleen, Hitchcock and Brown disclose the limitations similar to those in claim 23, and the same rejection is incorporated herein. Brown fails to specifically disclose obtaining an electronic signature. However, Holloway discloses use of an electronic signature (column 5, lines 35-55). It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention since it would have allowed for secure information transactions.

As per dependent claim 26, Paltenghe, Daleen, Hitchcock, Brown, and Holloway disclose the limitations similar to those in claim 23, and the same rejection is incorporated herein. Brown fails to specifically disclose the use of the TCP/IP protocol. However, Daleen discloses a network is the Internet, which is a TCP/IP protocol network (column 1, lines 20-57). It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined Daleen with Brown, since it would have allowed for the utilization of a protocol standard to communicate data over a network.

As per independent claim 29, the applicant discloses the limitations substantially similar to those in claim 23. Claim 29 is similarly rejected.

11. Claims 24 and 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over Paltenghe, Daleen, Hitchcock, Brown, and Holloway and further in view of Wiitala et al. (US 6122622, filed 18 February 1998).

As per dependent claim 24, Paltenghe, Daleen, Hitchcock, and Brown, and Holloway disclose the limitations similar to those in claim 23, and the same rejection is incorporated herein. Brown fails to specifically disclose receiving a filing fee. However, Wiitala discloses receipt of a filing fee (Abstract). It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined Wiitala with Brown, since it would have allowed a user to receive payment for services.

As per dependent claim 30, the applicant discloses the limitations substantially similar to those in claim 24. Claim 30 is similarly rejected.

12. Claim 32 is rejected under 35 U.S.C. 103(a) as being unpatentable over Daleen and Pearson.

As per independent claim 32, Daleen discloses an electronic filing system (column 4, lines 7-8; Figure 1, item 104: Here, the EFS is a database), wherein:

Documents are filed for further processing by a receiving agency associated with said receiving agency server in accordance with a procedure for which said receiving agency is in some manner responsible

A receiving agency server coupled to a wide area network (Figure 1, item 106)

Client machines coupled to a WAN that communicates to the receiving agency server (Figure 1, item 112)

Daleen fails to specifically disclose a web server coupled to a WAN that serves as an interface to the receiving agency server. However, Pearson shows the use of intermediate servers (Figure 2; columns 1-21). Pearson further indicates that one may employ a path such as a

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path from a client (Figure 2, items 26 or 28) to the web server (50) to the application server (56), allowing control and filtering of data flow. Pearson further discloses wherein the receiving agency server (Figure 2, item 48) is separate from the web server (Figure 2, item 50) and the agency computer believes it is in communication with a client machine (Figure 2). It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined Pearson with Daleen, since it would have allowed for filtering and control of data flow.

Daleen fails to specifically disclose wherein the filing is a trademark application, but the examiner takes official notice that filing of trademark application and payment for filling of such an application was notoriously well known in the art at the time of the applicant's invention. Therefore, it would have been obvious to have applied Daleen and Pearson to trademark applications, thereby allowing for efficient filing of trademark applications.

Response to Arguments

13. As an initial matter, the applicant has requested that documentation be provided to establish the that the Examiner's statement that the filing of trademark applications was notoriously well known in the art at the time of the applicant's invention (pages 19-20). The Examiner directs the applicant to "Expansion of Pilot of Electronic Filing of Trademark Applications" by Hampton for this teaching. The Hampton reference was cited as prior art pertinent to the applicant's disclosure in the Office Action mailed 14 April 2008.

14. Applicant's arguments with respect to claims 1, 5-6, 10-32 and 36 have been considered but are moot in view of the new ground(s) of rejection.

15. Although the applicant's arguments are moot in view of the new grounds of rejection, the examiner has addressed several of the applicant's arguments in order to expedite prosecution, as the basis for much of the rejection remains the same. These arguments have been fully considered but they are not persuasive.

With respect to claims 1, 5-6, and 10-20, the applicant argues that the database of Daleen does not meet the receiving agency server limitation (page 20). However, the Examiner does not rely on the database (Figure 1, item 104) of Daleen for disclosing a server. Instead, the Examiner relies upon the "Referring Page Web Server (Figure 1, item 106)" of Daleen for disclosing a receiving agency server. Therefore, this argument is not persuasive.

The applicant further argues that the Examiner points to Figure 5A of Daleen to disclose a web server which automatically provides a portion of the electronic document to the client machine in response to a selection originating from the client machine (pages 20-21). However, the Examiner notes that this limitation is newly added by the applicant's amendment filed 18 September 2008. It is unclear to the examiner how he allegedly applied this portion of Daleen to a limitation prior to the limitation being added to the claim. Therefore, this argument is not persuasive.

The applicant further argues that Pearson fails to disclose a web server coupled to a wide area network and a receiving agency server separate from the web server and coupled to the wide area network such that it is capable of communication with the web server (page 21). However,

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the Examiner respectfully disagrees. First, it must be pointed out that Pearson discloses a plurality of servers separate from each other (Figure 2). These separate servers include a web server (item 50) and a receiving agency servers, such as an application server, a database server, or a communication server (items 56, 58, and 60). Additionally, it must be appreciated that Figure 2 “illustrates data flow and not physical connections. Thus the reader should appreciate that servers 56, 58, and 60 may be coupled in a ring network or other physical connecting configuration (column 8, lines 20-23).” Therefore, the connection between the web server and the receiving agency servers may be implemented using a wide area network. This argument is not persuasive.

With respect to claims 21-26, the applicant argues that the prior art fails to disclose a web server coupled to the Internet (page 23). However, the Examiner respectfully disagrees. Daleen discloses a web server coupled to the internet (Figure 1, items 106 and 110). Therefore, this argument is not persuasive.

With respect to the rejection of claim 31, the applicant argues that Wiitala fails to disclose a filling fee and filing an electronic document with a government agency (page 25). It is unclear to the Examiner the basis for this argument. As an initial matter, prior to the amendment, claim 31 was rejected under 35 USC 103 over Daleen and further in view of Pearson. Further, the applicant’s arguments are directed toward limitations which are newly amended. It is unclear to the Examiner how he allegedly applied the Wiitala reference to the limitation which is newly added. Additionally, the Examiner will not comment upon the Wiitala reference, as it has yet to be cited against the claim.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KYLE R. STORK whose telephone number is (571)272-4130. The examiner can normally be reached on Monday-Friday (8:00-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong can be reached on (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kyle Stork/

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